



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,900	10/10/2003	Chong-Shien Tsai	MR933-553/CIP	7705

4586 7590 11/22/2004

ROSENBERG, KLEIN & LEE
3458 ELLICOTT CENTER DRIVE-SUITE 101
ELLICOTT CITY, MD 21043

EXAMINER

SY, MARIANO ONG

ART UNIT	PAPER NUMBER
----------	--------------

3683

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/681,900

Applicant(s)

TSAI ET AL.

S

Examiner

Mariano Sy

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

1. The disclosure is objected to because of the following informalities:

page 1, lines 4-5 "copending application" should be --abandoned case--,

page 2, line 1 "asismic" should be --aseismic--.

Appropriate correction is required.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they include the following reference character(s) not mentioned in the

description: "33" fig. 4A, "35" fig. 4H, and "35" fig. 5F. Corrected drawing sheets, or

amendment to the specification to add the reference character(s) in the description, are

required in reply to the Office action to avoid abandonment of the application. Any

amended replacement drawing sheet should include all of the figures appearing on the

immediate prior version of the sheet, even if only one figure is being amended. The

replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as

per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the

changes are not accepted by the examiner, the applicant will be notified and informed of

any required corrective action in the next Office action. The objection to the drawings

will not be held in abeyance.

3. The drawings are objected under 37 CFR 1.83(a). The drawings must show

every feature of the invention specified in the claims. Therefore, the limitation of the

Art Unit: 3683

connecting devices (plural) collectively forming a crossed sectional contour as claimed in claim 12 must be shown or the feature(s) canceled from the claim(s). Figure 7B simply shows one X-shaped connecting device between the two plates. No new matter should be entered. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification lacks proper antecedent basis for the phrase "said connecting device is formed of a metallic material" as recited in claim 20.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3683

6. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "said locating groove" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyazaki (JP 6-240919A).

Re-claims 1, 3, and 6 Miyazaki discloses, as shown in fig. 1a and 1b, a shock dampening system for mitigating the impact of mechanical shock imparted to a structure comprising: at least one damper body 6 for coupling to a first portion of the structure, said damper body including horizontal top and bottom plates 8 vertically offset one from the other, and at least one connecting device 7 extending vertically therebetween, said connecting device being fixedly attached to at least one of said horizontal top and bottom plates via 7b, said connecting device having a predetermined sectional contour and being multi-dimensionally deflectable relative to said top and bottom plates; and a supporting assembly coupled to said damper body for securement to a second portion

Art Unit: 3683

of the structure, said supporting assembly including a plurality of elongate braces 4 connected to extend from at least one of said horizontal top and bottom plates.

Re-claim 2 Miyazaki discloses wherein each of said horizontal top and bottom plates are substantially planar in contour, said horizontal top and bottom plates having respective inner faces disposed one opposed to the other, each of said horizontal top and bottom plates having at least one locating groove recess 7b formed in said inner face, said locating groove recess respectively engaging a portion of said connecting device.

9. Claims 1-9, 13-17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsai et al. (U.S. Patent Number 5,971,347).

Re-claims 1, 6, and 14-17 Tsai et al. disclose as shown in fig. 1-3, 8, and 9 a shock dampening system for mitigating the impact of mechanical shock imparted to a structure comprising: at least one damper body 10 for coupling to a first portion of the structure, said damper body including horizontal top 17 and bottom 26 or 16,26 plates vertically offset one from the other, and at least one connecting device 12 or 11,12,15 extending vertically therebetween, said connecting device being fixedly attached to at least one of said horizontal top and bottom plates, said connecting device having a predetermined sectional contour and being multi-dimensionally deflectable relative to said top and bottom plates; and a supporting assembly coupled to said damper body for securement to a second portion of the structure, said supporting assembly including a

Art Unit: 3683

plurality of elongate braces 2 connected to extend from at least one of said horizontal top and bottom plates as shown in fig. 8,9.

Re-claims 2, 4, and 5 Tsai et al. disclose wherein each of the horizontal top and bottom plates are substantially planar in contour, said horizontal top and bottom plates having respective inner faces disposed one opposed to the other, each of said horizontal top and bottom plates having at least one locating groove recess 18 in the top plate and the area between element 16 in the bottom plate formed in said inner face, said locating groove recess respectively engaging a portion of said connecting device.

Re-claim 3 Tsai et al. disclose wherein said connecting device is substantially cylindrical in contour in area of element 14 as shown in fig. 1.

Re-claims 7 and 8 Tsai et al. disclose as shown in fig. 6 wherein said connecting device being substantially triangular in elevation and being intermediately tapered inward in elevation contour.

Re-claim 9 Tsai et al. disclose as shown in fig. 1 wherein said connecting device includes a bottom end portion engaging the horizontal bottom plate, the bottom end portion including a horizontally extended cylindrical rod member 14.

Re-claim 13 Tsai et al. disclose the use of welding as means of connecting two elements particularly the connecting device and the horizontal top plate, see col. 2, lines 50-51.

Re-claim 20 Tsai et al. disclose wherein the connecting device being formed of a metallic material, see col. 2, lines 41-42.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 4, 7, 8, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazaki (JP 6-240919A).

Since applicant fails to disclose the criticality of the connecting device being I-shaped, triangular, intermediately tapered inward in elevational contour or crossed sectional contour, it is maintained that it would have been obvious to one of ordinary skill in the art to have modified the shape of the connecting device of Miyazaki, to have included any appropriate shape as determined by routine experimentation in order to provide an alternate functional equivalent means of connecting two components. In re

Art Unit: 3683

Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) the court held that the configuration of the claimed object was a matter of design choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed object was significant.

13. Claims 12, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al.

Re-claim 12, since Tsai et al. fails to disclose the criticality of the connecting device being crossed sectional contour, it is maintained that it would have been obvious to one of ordinary skill in the art to have modified the shape of the connecting device of Tsai et al., to have included any appropriate shape as determined by routine experimentation in order to provide an alternate functional equivalent means of connecting two components. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) the court held that the configuration of the claimed object was a matter of design choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed object was significant.

Re-claims 18 and 19, since Tsai et al. fails to disclose the criticality of the members being integrally formed, it would have been obvious to one of ordinary skill in the art to have modified the connecting device and the top plate of the damper body of Tsai et al. to have been integrally formed in order to provide a functional equivalent alternate means of attaching the two components. In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) the court held that the use of a one piece construction

Art Unit: 3683

instead of several pieces rigidly secured together would merely be a matter of obvious engineering choice.

14. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al. '347 in view of Tsai et al. (U.S. Patent Number 5,533,307).

Re-claims 10 and 11 Tsai et al. '347 disclose in fig. 1 a horizontally extended cylindrical rod members 14 but failed to disclose the horizontal bottom plate has formed therein a plurality of locating groove recesses respectively engaging the cylindrical rod members of the connecting devices.

Tsai et al. '307 teaches, as shown in fig. 4, a connecting device having a horizontal bottom plate formed therein a plurality of locating groove recesses 921 respectively engaging the cylindrical rod members 7.

It would have been obvious to one of ordinary skill in the art to have modify the connecting device of Tsai et al. '347 with plurality of locating groove recesses respectively engaging the cylindrical rod members, as taught by Tsai et al. '307, in order to effectively dissipate large amount of seismic energy.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

W.D. Harper U.S. Patent Number 2,359,036,

Robinson U.S. Patent Number 4,117,637,

Bschorr et al. U.S. Patent Number 4,133,157,

Art Unit: 3683

Fyfe et al.	U.S. Patent Number 4,187,573,
Buckle et al.	U.S. Patent Number 4,499,694,
Mostaghel	U.S. Patent Number 4,633,628,
White	U.S. Patent Number 4,823,522,
Scholl	U.S. Patent Number 4,910,929,
Kemeny	U.S. Patent Number 5,490,356,
Yen et al.	U.S. Patent Number 6,126,136,
Huyett	U.S. Patent Number 6,230,460 B1,
Hayashi	JP 62-224750-A,
Hayashi	JP 1-226977-A,
Hayashi	JP 1-268963-A,
Hayashi	JP 2-183018-A.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mariano Sy whose telephone number is 703-308-3427. The examiner can normally be reached on Mon.-Fri. from 9:00 A.M. to 3:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder, can be reached on 703-308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 3683


Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Sy

M. Sy

November 2, 2004


JACK LAVINDER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600